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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,087	09/21/2000	Kazunori Ukigawa	59684-011	8898

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Washington, DC 20005-3096

EXAMINER
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EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/666,087	Applicant(s) UKIGAWA ET AL.	
	Examiner Hussein A El-chanti	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-20 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. This action is responsive to amendment received on June 23, 2004. Claims 1-20 were amended. Claims 1-20 are pending examination.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 and 8-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson, U.S. Patent No. 6,609,106.

As to claim 1, Robertson teaches a network system which comprises a server and a plurality of terminals connected to said server via a network and is to provide predetermined service to said terminals via said network from said server (Fig. 1 shows a server with a service provider connected to a user terminal through a network), wherein said server comprises:

request receiving means transmitted by terminals (see col. 9 lines 55-col. 10 lines 16);

information transmitting means (see col. 10 lines 17-30 and 45-49);

incentive offering means for offering predetermined incentive to only some of said terminals (see col. 13 lines 23-33);

requests count means for counting transmitted requests (see col. 13 lines 5-20);

incentive modifying means for modifying contents of the incentive offered according to the number of said terminals (see col. 13 lines 5-20);

each of said terminals comprises:

request transmission means for transmitting a request to said server for providing the service via said network (see col. 12 lines 26-34); and

information receiving means for receiving information corresponding to service to be provided (see col. 12 lines 62-65 and col. 13 lines 61-67).

As to claim 2, Robertson teaches the system of claim 1 wherein said server further comprises promotional information transmitting means for transmitting information for promoting requests for the service together with information representing contents of the incentive to be offered to predetermined terminals of said plural terminals via said network (see col. 21 lines 16-30).

As to claim 3, Robertson teaches a network system which comprises a server and a plurality of terminals connected to said server (Fig. 1 shows a server with a service provider connected to a user terminal through a network), wherein said server comprises:

a memory for storing a program, a processor for executing said program, and a first communication device for transmitting/receiving information to/from said terminals (see claim 16);

receive a request transmitted by terminals (see col. 9 lines 55-col. 10 lines 16);

counts the number of said terminals which transmitted the request (see col. 13 lines 5-20);

transmit information to the terminals (see col. 10 lines 17-30 and 45-49);

offers an incentive in regard to use of said predetermined service to only some of the terminals each of which has transmitted the request to said server (see col. 13 lines 13-23);

incentive offering means for offering predetermined incentive to at least some of said terminals (see col. 13 lines 23-33);

modifies contents of the incentive offered according to the number of said terminals and transmit information to said terminals(see col. 13 lines 5-20);

each of said terminals comprises:

a memory for storing a program, a processor for executing said program, an output device for outputting information and a second communication device for transmitting/receiving information to/from said server (see col. 15 lines 19-30).

request server to provide the service (see col. 12 lines 26-34); and

receives information transmitted by said server (see col. 12 lines 62-65 and col. 13 lines 61-67).

outputs the received information through output device.

As to claim 8, Robertson teaches a server being connected to a plurality of terminals (Fig. 1 shows a server with a service provider connected to a user terminal through a network), comprising:

incentive offering means for offering predetermined incentive to only some of said terminals (see col. 13 lines 23-33);

requests count means for counting transmitted requests (see col. 13 lines 5-20);

incentive modifying means for modifying contents of the incentive offered according to the number of said terminals (see col. 13 lines 5-20);

As to claim 9, Robertson teaches the server of claim 8 wherein said means that counts the number of terminals which did not request the service as the number of the terminal requesting the service (see col. 13 lines 5-20).

As to claim 10, Robertson teaches the server of claim 8 wherein said incentive means modifies the content of the incentive when the number of terminals counted reaches predetermined number (see col. 13 lines 5-20).

As to claim 11, Robertson teaches the server of claim 10 further comprising visible information transmitting means for transmitting information which visibly shows the relationship between the number of terminals when the said incentive modifying means modifies the contents of the incentive and the number of terminals counted by said request count means to the terminals which have requested the service via the network (see col. 13 lines 5-20).

As to claim 12, Robertson teaches the server of claim 8 comprising promotional information transmitting means for transmitting information to predetermined terminals through said network (see col. 10 lines 17-30 and 45-49).

As to claim 13, Robertson teaches the server of claim 12 wherein said promotional information transmitting means comprises address information storage means which stores address information of terminals and transmits information for promoting service request in accordance with the address information stored in said address information storage means (see col. 24 lines 34-47).

As to claim 14, Robertson teaches the sever of claim 13 wherein said information storage means stores the address information with dividing it into groups in accordance with predetermined standards, and

said promotional information transmission means transmits information for promoting service request in accordance with the address information belonging to any one of the groups corresponding to the contents of the incentive to be offered by said incentive offering means (see col. 10 lines 56-col. 11 lines 3 and col. 24 lines 34-47).

As to claim 15, Robertson teaches the server of claim 12 wherein said promotional information transmitting means comprises address information receiving means which receives address information of other terminals transmitted by the terminal which has requested the service via said network and transmits the information for providing service request in accordance with the address information received by said address information receiving means (see col. 24 lines 34-47).

3. Claims 4-7, 16-20 do not teach or define any additional limitation over claims 1-3 and 8-15 and therefore are rejected for similar reasons.
4. Applicant's arguments filed have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that; A) Robertson does not teach incentive offering means for offering predetermined incentive to only some of said terminals B) Robertson does not teach count means for counting transmitted requests

In response to A) Robertson teaches a method of notifying an SP when the number of requests for product has reached a predetermined number. The SP then checks which users did not opt out of agreeing to receive marketing information and then sends incentive or customized advertisements to those group of people. The example used by Robertson on col. 13 is when the number of requests has reached 100, the SP is notified of the event. The SP then checks which users chose to receive notifications and sends customized online services to users where as the group of users who did not choose to receive notifications are not sent customizable online services (see col. 13 lines 10-36). Therefore Robertson teaches a method of sending incentives only to the users that chose to receive notifications and not to all users and therefore Robertson meets the scope of the claimed limitation "incentive offering means for offering predetermined incentive to only some of said terminals".

In response to B) Robertson teaches an apparatus for notifying an SP when the number of requests for product has reached a predetermined number. For example the SP is notified when the number of requests for a certain product have reached 100 (see



col. 3 lines 10-23). It is inherent that Robertson has a count means to count the number of requests made by users or count means to count to 100 and therefore Robertson meets the scope of the claimed limitation "requests count means for counting transmitted requests.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A El-chanti whose telephone number is (703)305-4652. The examiner can normally be reached on Mon-Fri 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

Sep. 21, 2004

  
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